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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,966	12/30/2004	Ze'ev Sohn	06727/0202039-US0	1948
7278	7590	06/04/2009	EXAMINER	
DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			FLICK, JASON E	
			ART UNIT	PAPER NUMBER
			3763	
			MAIL DATE	DELIVERY MODE
			06/04/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/511,966	<b>Applicant(s)</b> SOHN, ZE'EV	
	<b>Examiner</b> JASON FLICK	<b>Art Unit</b> 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-124 is/are pending in the application.
- 4a) Of the above claim(s) 1-84 and 99-124 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 85-98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/5/05;2/14/07;4/12/07;12/07/07</u> . | 6) <input type="checkbox"/> Other: _____  |



**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Group 3, claims 85-98, in the reply filed on 01/21/2009 is acknowledged.
2. As a matter of record, the examiner acknowledges Applicant has elected claims, directed toward a method and device for sequentially activating electrodes for therapeutic transdermal substance delivery, which will be examined through the remainder of prosecution of this application.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 85-87 and 92-94 are rejected under 35 U.S.C. 102(e) as being anticipated by Coston et al. (PGPub 2002/0010414).
5. [Claims 85 and 92] Coston teaches an apparatus and method for facilitating transport of a substance through an area of skin of a subject (figure 4, item 400), the area defining a set of ablation sites (figure 4, item 50), the apparatus comprising: a plurality of electrodes, which are adapted to be placed in contact with the area of the skin at the ablation sites (figure 4, item 16); a method comprising driving current in a

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sequence into more than one of the ablation sites (figure 4); and a control unit (figure 4, item 12), adapted to drive, during successive first, second, and third time periods, a current capable of ablating stratum corneum of the skin to a first one, a second one, and a third one of the electrodes, the first one of the electrodes being non- adjacent to the second one of the electrodes, and the second one of the electrodes being non-adjacent to the third one of the electrodes, so as to facilitate transdermal transport of the substance (page 7, paragraphs [0068]-[0069]; page 13, paragraph [0122]).

6. [Claims 86 and 93] Coston teaches the limitations and method steps of claims 85 and 92, upon which claims 86 and 93 depend. In addition, Coston discloses wherein the control unit is adapted to drive the current in sequence to typically maximize a minimum distance between electrodes into which current is driven during successive time periods (page 13, paragraph [0122]).

7. [Claims 87 and 94] Coston teaches the limitations and method steps of claims 85 and 92, upon which claims 87 and 94 depend. Coston further discloses the control is adapted to drive the current such that a sum of distances between temporally adjacent ones of the electrodes into which current is driven is typically greater than such sum would be if a sequence of electrodes is generated randomly (page 13, paragraph [0122]).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 88-91 and 95-98 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Coston et al. (PGPub 2002/0010414).

11. [Claims 88, 89, 95, and 96] Coston teaches the limitations and method steps of claims 85 and 92, upon which claims 88, 89, 95, and 96 depend. Coston teaches the method and apparatus as claimed, wherein the control unit is capable of controlling the waveform, frequency, voltage, amperage, and duration of the current (page 7, paragraphs [0068]-[0069]), except does not specifically state the current is driven 10 successive times. It would have been obvious to one of ordinary skill in the art at the time of the invention to drive the current a select number of times, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Also, Coston discloses that the device is capable of being configured such that a distance between successive sites of application of the current during each of the periods is greater than 3 mm (page 13, paragraph [0122]).

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12. [Claims 90, 91, 97, and 98] Coston teaches the limitations and method steps of claims 85 and 92, upon which claims 90, 91, 97, and 98 depend. Coston teaches the method and apparatus as claimed, wherein the control unit is capable of controlling the waveform, frequency, voltage, amperage, and duration of the current (page 7, paragraphs [0068]-[0069]), except does not specifically state the current is driven 10 successive times. It would have been obvious to one of ordinary skill in the art at the time of the invention to drive the current a select number of times, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In addition, Coston teaches the control unit is capable of being adapted to drive the current during at least 10 successive time periods into respective ones of the electrodes, such that, for each of the periods, during temporally adjacent ones of the time periods, the current is driven into non- adjacent electrodes; or such that during none of the time periods is the current driven into adjacent electrodes (page 13, paragraph [0122]).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON FLICK whose telephone number is (571)270-7024. The examiner can normally be reached on Monday through Thursday, 7:00am to 5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. F./

Examiner, Art Unit 3763  
06/02/2009

/Nicholas D Lucchesi/

Supervisory Patent Examiner, Art Unit 3763